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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,437	03/25/2004	Masami Suwama	2004-0483A	6940

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EXAMINER

FLETCHER III, WILLIAM P

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/808,437

Applicant(s)

SUWAMA ET AL.

Examiner

William P. Fletcher III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 16-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment and remarks filed June 12, 2006 in noted.
2. Claims 1-13 and 16-21 are pending.

Election/Restrictions

3. Claims 20 and 21 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 2, 2005.

Response to Arguments

4. Applicant's arguments, see the remarks, filed June 12, 2006, with respect to the rejections under 35 USC 112, 2nd Para., set forth in the prior Office action, have been fully considered in light of applicant's amendment filed June 12, 2006, and are persuasive. The rejections are withdrawn.
5. Applicant's arguments filed June 12, 2006 have been fully considered but they are not persuasive.

A. Applicant argues:

Rink et al. teach that the coating composition may additionally contain one or more other hydroxyl group-containing resins, and the reference teaches suitable hydroxyl group-containing acrylate resins at column 9, lines 4-41. When these resins are used in place of hydroxyl-containing oligomer (C), as recited in Applicant's claims, they fail to give a clear paint which forms a coating film excellent in adhereability and finishing property. This is clearly demonstrated in Comparative Example 11 of the Rule 1.132 Declaration submitted with the Response of November 14, 2005.

This argument is noted but is not persuasive. The claims are rejected as obvious over the combination of Rink in view of Marutani. A Rule 1.132 declaration is considered insofar as

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it weighs against the *prima facie* case of record.¹ As noted at paragraph 7 of the prior Office action, the declaration is insufficient to overcome the rejection of claims 1-19 because Marutani explicitly suggests the incorporation of applicant's claimed component (C) for the same reasons set-forth by applicant (i.e., hardness, etc.). Consequently, because expected beneficial results are evidence of obviousness of a claimed invention, just as unexpected results are evidence of unobviousness thereof,² the declaration does not weight against the *prima facie* case of record.

B. Applicant argues:

Rink et al. fail to teach or suggest the hydroxyl-containing oligomer (C) of Applicant's claims. Further, Rink et al. fail to provide any motivation to look outside the teachings of the reference for other suitable resins. On the contrary, the disclosure of Rink et al. provides suitable resins. Therefore, any suggestion to look outside the teachings of Rink et al. for other resins is necessarily based on hindsight, which is improper according to U.S. practice. The Examiner has cited no evidence to support the conclusion that it would have been obvious to modify the teachings of Rink et al. to incorporate other resins not taught by Rink et al. In the absence of such evidence, Applicant respectfully submit that [the rejections should be withdrawn].

This argument is noted but is not persuasive. The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.³ Rink teaches that, in addition to components (A) and (B), the composition may additionally include:

...one or more other hydroxyl group-containing resins, whereby, for example, the solvent resistance and hardness of the resulting coating are improved further. For example, they may contain...polyesters. These further binders are usually employed in a quantity of from 0 to 25% by weight.... [8:51-62, emphasis added]

¹ MPEP 716.01(d)

² MPEP 716.02(c)

³ MPEP 2123(I)

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Notice the use of the words "for example." Applicant is reminded that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art and disclosed examples do not constitute a teaching away from a broader disclosure.⁴ While the above disclosure teaches examples of suitable resins, it is clear that the broader disclosure is of any hydroxyl group-containing resin suitable for improving solvent resistance and hardness. Marutani teaches just such a resin, as explained at page 6 of the prior Office action. The strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, that some advantage or expected beneficial result would have been produced by their combination.⁵ It is clear from the disclosures of Rink and Marutani, taken as a whole,⁶ that the resin of Marutani is suitable for achieving the explicitly stated, desired result of Rink. Consequently, the combination of Rink and Marutani represents the strongest sort of *prima facie* case.

C. Applicant argues:

Absent hindsight, it would have been impossible to foresee the superior effects which were attained by the use of the specific hydroxyl-containing oligomer (C) in addition to hydroxyl-containing acrylic resin (A) and curing agent (B). One skilled in the art would not have been motivated to use the star-type polyesters of Marutani et al. in place of the hydroxyl group-containing resin of Rink et al., because there is not reason to modify the teachings of Rink et al.

This argument is noted but is not persuasive for the reasons set forth in paragraph 5(B) above. As noted in the prior Office action, Marutani explicitly suggests the incorporation of

⁴ MPEP 2123(II)

⁵ *In re Sernaker*, 702 F.2d 989, 994-95, 217 USPQ 1, 5-6 (Fed. Cir. 1983)

⁶ *In re Conrad*, 169 USPQ 170 (CCPA 1971)

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applicant's claimed component (C) for the same reason set forth by both applicant and Rink (i.e., hardness, etc.).

D. Applicant argues:

Furthermore, in Marutani et al., the star-type polyesters are used singly as a main binder component. Marutani et al. fail to teach or suggest using the star-type polyesters additionally, in combination with hydroxyl-containing acrylic resin (A) as a main binder component, as in the present invention of Rink et al. One of the ordinary skill in the art would not have been motivated, either by Marutani et al. or by Rink et al., to use the star-type polyesters of Marutani et al. in place of the hydroxyl-containing resin as an additional component in the coating composition of Rink et al.

This argument is noted but is not persuasive. The claims do not recite (A) and (C) in combination as main binder components. Rather the claims recite a composition comprising (A) and (C) in no particular relationship other than that the two are merely contained part of the clear paint. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

E. New grounds of rejection are set forth below addressing applicant's newly-added limitation concerning the substrate.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not

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commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1, 3-13, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rink et al. (US 6,013,739 A) in view of Marutani et al. (US 6,040,009 A) and Ido et al. (US 2002/0013398 A1).

A. Rink and Marutani are applied herein again as set-forth under this heading in the prior Office action.

B. While Rink teaches that the substrate may be a plastic automotive substrate [10:20-29], none of the cited references explicitly teaches that such substrates are ABS or PC components.

C. Ido teaches that examples of plastic automotive components that may be coated with multi-layer coating films include ABS plastics [0004].

D. Consequently, it would have been obvious to one of ordinary skill in the art to utilize, as the plastic substrate, an ABS resin plastic substrate. One of ordinary skill in the art would have been motivated by the desire and expectation of successfully providing a decoratively-coated plastic automotive component, as desired by Rink.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rink et. al, Marutani et al., and Ido et al., as applied to claim 1 above, and further in view of Asahina et al. (US 5,817,732 A) and Croft (US 5,688,860 A).

A. Rink, Marutani, and Ido are applied herein again as set-forth under this heading in the prior Office action.

B. Asahina and Croft render this claim obvious for the reasons set forth in the prior Office action.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

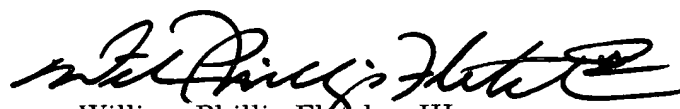
11. The prompt development of clear issues in the prosecution history requires that applicant's reply to this Office action be fully responsive (MPEP § 714.02). When filing an amendment, applicant should specifically point out the support for any amendment made to the disclosure, including new or amended claims (MPEP §§ 714.02 & 2163). A fully responsive reply to this Office action, if it includes new or amended claims, must therefore include an explicit citation (i.e., page number and line number) of that/those portion(s) of the original disclosure which applicant contends support(s) the new or amended limitation(s).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 0900h-1700h.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



William Phillip Fletcher III
Patent Examiner (FSA), USPTO
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Fredericksburg, VA
August 11, 2006